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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,163	08/30/2001	Thomas J. Schall	019934-000310US	9088

20350 7590 03/31/2004

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EXAMINER	
JIANG, SHAOJIA A	

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/944,163	SCHALL ET AL.	
	Examiner	Art Unit	
	Shaojia A Jiang	1617	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): U.S.C. 112 first paragraph for lack of scope of enablement

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *see attaactment*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: *none*.

   Claim(s) objected to: *none*.

   Claim(s) rejected: *5, 8-13, 29 and 31-40 (all)*.

   Claim(s) withdrawn from consideration: *none*.

SHAOJIA ANNA JIANG
PATENT EXAMINER
3/27/04

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Advisory Action

This Office Action is a response to Applicant's response and amendment after FINAL filed on March 17, 2004 will be entered, wherein claims 5, 8, 29, and 31-40 have been amended and claims 1-4, 6-7, 14-28 and 30 are cancelled.

Currently, claims 5, 8-13, 29 and 31-40 are pending in this application.

4, Applicant's amendment amending claims 5 and 29, filed March 17, 2004 with respect to the rejection made under 35 U.S.C. 112 first paragraph for lack of scope of enablement in these claims of record stated in the Office Action dated January 14, 2004 has been fully considered and is found persuasive to remove the rejection since the recitation, "a small organic compound having a molecular weight of less than 800 daltons and which blocks or inhibits the binding of a chemokine to US28 receptor or a US28 receptor fragment" has been removed and replaced with the particular compounds of formula.

5. Applicant's response and amendment filed March 17, 2004 with respect to the rejection of all pending claims made under 35 U.S.C. 103(a) as being unpatentable over Protiva et al. (4,243,805, of record) in view of in view of the Merck Manual of Diagnosis and Therapy (17th ED, of record) and Michelson (of record), and the rejection of Claims 29-40 made under 35 U.S.C. 103(a) as being unpatentable over Sindelar et al. (of record) in view of in view of the Merck Manual of Diagnosis and Therapy (17th

ED) and Michelson (of record), have been fully considered but are unpersuasive for reasons of record stated in the Final Office Action dated January 14, 2004.

Appellants' arguments regarding the inherency under 35 U.S.C. 102(b) are moot since the instant claims are rejected under 35 U.S.C. 103(a) in the prior Office Action mailed, and no anticipation rejection is currently applied.

Applicants aver surprising or unexpected results residing in the claimed subject matter. However, Applicant's Examples 1-3 of the specification at pages 17-18 herein have been fully considered but are not deemed persuasive as to the nonobviousness and/or unexpected results of the claimed invention over the prior art, since the testing in *vitro* in Examples 1-3 provides no clear and convincing evidence for treating CMV infection in a human. Evidence as to unexpected benefits must be" clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963). Applicant has the burden to explain the experimental evidence. See *In re Borkowski and Van Venrooy* 184 USPQ 29 (CCPA 1974).

Applicant argues that "Nor, is there any requirement that a specification set forth a side-by-side comparison of the inventive method with the prior art method to support a surprising result". Applicant is requested to note that it is well-settled that the evidence including a comparison with the closest prior art is one of elements to be considered as unexpected results (see for example, *In re Merchant*, 575 F.2d 865, 869, 197 USPQ 785, 788 (CCPA 1978), which is provided either in the specification or an affidavit or declaration submitted during prosecution on the issue.

Again, arguments of counsel cannot take the place of factually supported objective evidence. See, e.g., In re Huang, 100 F.3d 135,139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); In re De Blauwe, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984).

Therefore, one of ordinary skill in the art would have reasonably expected that the particular compounds of formula (1) would have beneficial therapeutic effects in treating CMV infection in a human who suffers severe brain damage, CNS damage, or CNS disorders caused by CMV, absent persuasive evidence.

For the above stated reasons, said claims are properly rejected under 35 U.S.C. 103(a). Therefore, said rejection is adhered to.

Applicant is suggested to amend the specification as to page 1 "Cross-References to Related Applications" since several provisional applications Serial No. are absent herein.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is 571.272.0627. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on 571.272.0629. The

fax phone number for the organization where this application or proceeding is assigned is 703.872.9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

S. Anna Jiang, Ph.D.
Patent Examiner, AU 1617
March 27, 2004